

REMARKS

This is in full and timely response to the Office Action mailed on December 6, 2004. Reexamination in light of the amendments and the following remarks is respectfully requested.

Claims 15-30, 32-35 and 37-41 are currently pending in this application, with claims 15, 33 and 40 being independent. *No new matter has been added.*

Claim objections

While not conceding the propriety of these objections and in order to advance the prosecution of the above-identified application, claims 18-19 and 38 have been amended, and claims 31 and 36 have been canceled.

Withdrawal of these objections and allowance of the claims is respectfully requested.

Rejections under 35 U.S.C. §112

While not conceding the propriety of these objections and in order to advance the prosecution of the above-identified application, the claims have been amended.

The Office Action includes a rejection under 35 U.S.C. §112, second paragraph for the use within independent claims 24 and 38 of the term “upgraded.”

“For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). In this regard, the term “upgraded” is deemed proper since page 5, lines 21-24 provides that the case can therefore serve as an *upgrade* of the original electronic device, providing additional or specialized features that suits the user. In addition, page 7, lines 18-33, provides that:

According to the principles of the invention, the controlling interface 6 can be used as an *upgraded* set of controls. For example, the exterior user controls 7 located on the controlling interface 6 can produce numerous command signals, including command signals that operate functions that are not operated by the user controls and control circuitry 10 of the original electronic device 2. Thus, a user of the original electronic device 2 can avoid purchasing a new version of the electronic device by simply purchasing a less expensive protective case 1 that includes a controlling interface 6 similar to that of the new version of the electronic device. The case 1 consequently provides the advantages of *upgrading* the electronic device 2 as well as protecting the electronic device 2.

According, the specification provides a standard for ascertaining the requisite degree, and one of ordinary skill in the art would be reasonably apprised of the scope of the invention.

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Rejections under 35 U.S.C. §102 and 35 U.S.C. §103

Claims 15-29, 31 and 33-39 were rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 5,313,596 to Swindler et al. (Swindler).

Claim 30 was rejected under 35 U.S.C. §103 as allegedly being obvious over Swindler in view of U.S. Patent No. 6,005,368 to Frame.

Claim 32 was rejected under 35 U.S.C. §103 as allegedly being obvious over Swindler in view of U.S. Patent No. 5,864,708 to Croft et al. (Croft).

These rejections are traversed at least for the following reasons.

Independent claim 15 includes the features of:

protective material for accepting said electronic device, said protective material enclosing said electronic device to maintain said electronic device within said case, the shape of said case when accepting said electronic device being different than said shape of said case when enclosing said electronic device; and

a controlling interface, said controlling interface having exterior user controls disposed on said protective material for manipulation by a user of said electronic device, said electronic device maintained within said case being controllable by said exterior user controls,

wherein said electronic device has user controls and control circuitry, said exterior user controls being separate from said user controls and control circuitry.

Claim 15 and the claims dependent thereon set forth *the shape of said case when accepting said electronic device being different than said shape of said case when enclosing said electronic device*. Support for this feature is found at least within figures 2a and 2b of the specification as originally filed, along with their associated description found within the specification as originally filed at least at page 5, lines 6-11.

Swindler arguably teaches a motorized portable computer/expansion chassis. The Office Action contends that figure 1 of Swindler teaches the presence of a case 14 and an electronic device 28 (Office Action at page 3). However, Swindler fails to disclose, teach or suggest the shape of case 14 when accepting the electronic device 28 being different than shape of the case 14 when enclosing the electronic device 28.

Frame arguably teaches a charging system for a computer that includes a computer 12 and a charging circuit 14 (Frame at figure 1). Yet, Frame fails to disclose, teach or suggest the shape of a case when accepting an electronic device being different than shape of the case when enclosing the electronic device.

Croft arguably teaches a docking station for docking a portable computer with a wireless interface. Like Swindler and Frame, Croft fails to disclose, teach or suggest the shape of

a case when accepting an electronic device being different than shape of the case when enclosing the electronic device.

Independent claim 33 includes the steps of:

accepting an electronic device within a case, said electronic device having user controls and control circuitry;

enclosing said electronic device within said case, the shape of said case when accepting said electronic device being different than said shape of said case when enclosing said electronic device;

disposing exterior user controls of a controlling interface on said case; and

using said exterior user controls to control said electronic device enclosed within said case,

wherein said exterior user controls are for manipulation by a user of said electronic device, and

wherein said exterior user controls are separate from said user controls and control circuitry.

Claim 33 and the claims dependent thereon set forth *the shape of said case when accepting said electronic device being different than said shape of said case when enclosing said electronic device*. Support for this feature is found at least within figures 2a and 2b of the specification as originally filed, along with their associated description found within the specification as originally filed at least at page 5, lines 6-11.

Swindler fails to disclose, teach or suggest the shape of case 14 when accepting the electronic device 28 being different than shape of the case 14 when enclosing the electronic device 28. Frame and Croft also fail to disclose, teach or suggest the shape of a case when accepting an electronic device being different than shape of the case when enclosing the electronic device.

Independent claim 40 includes the features of:

protective material for accepting said electronic device, said protective material using a fastening device to enclose said electronic device within said case, a hook and loop fastener member being used as said fastening device to enclose said electronic device within said case; and

a controlling interface, said controlling interface having exterior user controls disposed on said protective material for manipulation by a user of said electronic device, said electronic device enclosed within said case being controllable by said exterior user controls,

wherein said electronic device has user controls and control circuitry, said exterior user controls being separate from said user controls and control circuitry.

Claim 40 and the claims dependent thereon include *a hook and loop fastener member being used as the fastening device to enclose the electronic device within the case*. Support for this feature is found within the specification as originally filed at least at page 5, lines 11-14.

Yet, Swindler, Frame and Croft, either individually or in combination, fail to disclose, teach or suggest a hook and loop fastener member being used as the fastening device to enclose the electronic device within the case.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 8, 2005

Respectfully submitted,

By _____

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